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09/875,477	06/06/2001	Kenneth P. Hinckley	m61.12-0318	7953

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EXAMINER

SHAPIRO, LEONID

ART UNIT	PAPER NUMBER
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2629

DATE MAILED: 06/20/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/875,477	Applicant(s) HINCKLEY ET AL.	
	Examiner Leonid Shapiro	Art Unit 2629	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 April 2006.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 5,9-14 and 31-33 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 5,9-14 and 31-33 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>4-27-06</u> | 6) <input type="checkbox"/> Other: _____ |

Drawings

1. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the newly introduced limitations of Claims 5,9: "display orientation context value" must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Specification

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2. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required:

The newly introduced limitations of Claims 5, 9: "display orientation context value" are not described in the specification.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 5, 9 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The newly introduced limitations of Claims 5, 9: "display orientation context value" are not described in the specification or shown in Figures.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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4. Claim 9 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

It is not clear what is different between "display orientation context value " and "tilt context value"?

Because the new matter situation and indefiniteness, claims 5 and 9 will not be rejected on prior art.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 31-33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Thomas (6,567,101) in view of Smith (US Patent No. 5,963,952).

Thomas (figures 1A-1C) teaches a display device and has a sensor (detector) for sensing the tilt of the display device (col. 4, lines 13-38), and wherein the text is being scrolled based on the tilting of the device (orientation) (col. 5, lines 41-60 and col. 21-45).

Thomas does not disclose that at least one tool bar that was shown on the display is removed.

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Smith teaches at least one tool bar that was shown on the display is removed (See Figs. 9-10, Col. 11, Lines 55-60).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to include the teaching of Smith into Thomas system in order to provide a consistent user interface (See col. 2, lines 43-47 in the Smith reference).

6. Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Lands in view of Watanabe (Japanese patent Publication NO. 6-292826).

As to claim 10 Lands (figure 1) teaches a portable display device (10) that includes, generating at least one sensor signal using at least one sensor in the device (36 & 38) and generating a tilt context value(first context) (figures 4B-4E) that indicates how the device is tilted (col. 3, lines 54-64), and a flat context value that indicates that the device is laying flat (figure 4A) based on the at least one sensor signal and selecting an orientation for an image on the display when the flat context value indicates the device is laying flat (col. 5, lines 6-46).

As to claim 10, Lands shows all the limitations of claim 10 except the citation of placing the device in a full power mode based on the holding context value and the orientation context value.

However, Watanabe teaches a display device (figure 2) that includes a power saving mode, which activated when no touches by the user is detected and the normal

mode is activated when the device is detected to be touched by the user (see English abstract).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to include the teaching of Watanabe to put the device in normal mode when sensing the user's touch to be incorporated to Lands device so as motivated by Watanabe, to provide a power saving data processor which saves the electric power more and is easy for a user to use (See Purpose in Watanabe reference).

7. Claim 12 is rejected under 35 U.S.C. 103(a) as being Unpatentable over Lands in view of Watanabe and Schultz et al. (US Patent No. 6,970,182B1).

As to claim 12, Lands shows all the limitations of claim 10, except the citation of placing the device in a full power mode based on the holding context value and the orientation context value.

However, Watanabe teaches a display device (figure 2) that includes a power saving mode, which activated when no touches by the user is detected and the normal mode is activated when the device is detected to be touched by the user (see English abstract).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to include the teaching of Watanabe to put the device in normal mode when sensing the user's touch to be incorporated to Lands device so as motivated by Watanabe, to provide a power saving data processor which saves the electric power more and is easy for a user to use (See Purpose in Watanabe reference).

Lands and Watanabe do not disclose at least one sensor that indicates the distance to an object and enter idle state when object is not moving.

Shultz et al. teaches at least one sensor that indicates the distance to an object and enter idle state when object is not moving (See Fig. 8, item 308, Col. 10, Lines 21-43).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to include the teaching of Shultz et al. into Watanabe and Lands system to provide detecting presence of an object (See Col. 3, Lines 51-54 in the Shultz et al. reference).

8. Claim 14 is rejected under 35 U.S.C. 103(a) as being Unpatentable over Lands in view of Anderson (US Patent No. 5,714,997).

As to claim 14, as can be seen above with respect to claim 10, Lands shows all the limitations of claim 10 except the citation of activating a sound capturing application based on the holding context value and orientation context.

However, Anderson teaches activating a sound capturing application based on the holding context value and orientation context (See Col. 2, Lines 35-47). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to include the teaching of Anderson into Lands system in order to increase the viewer sensation (See Col. 1, Lines 31-34).

Response to Arguments

10. Applicant's arguments with respect to claims 10-12, 14 and 31-33 have been considered but either moot in view of the new ground(s) of rejection or not persuasive.

With respect to claim 9, Applicant stated on page 10, paragraph 2, that Norden does not teach to use tilting of a device to change the orientation of a displayed image. However, Norden is teaching tilting of a device to change the orientation of a displayed image (See Figs 1A-1B), where orientation of image changed from the center to the bottom of the display.

On the same page, 4th paragraph that neither Lands nor Norden show or suggest to use tilting of a device to change the orientation of a displayed image or scrolling. However, Norden is teaching tilting of a device to change the orientation of a displayed image (See Figs 1A-1B), where orientation of image changed from the center to the bottom of the display and Lands teaches scrolling (See Figs. 4B-4E, Col. 5, Lines 6-46)

With respect to claim 10, as can be seen in the rejection above with respect to claim 10, Watanabe is cited to show changing the power based on the detection of whether the user is touching or not touching the device.

On page 12, 2nd paragraph Applicants stated that Watanabe does not show or suggest using an orientation context value to control power mode. But orientation context value limitation was shown by Lands. However, Applicants cannot show non-obviousness by attacking references individually where, as here the rejections are based on combination of references. In Keller, 208 USPQ 871 (CCPA 1981).

On page 12, 3rd paragraph Applicants stated that Lands does not show or suggest to control power mode. But control power mode limitation was shown by Watanabe. However, Applicants cannot show non-obviousness by attacking references individually where, as here the rejections are based on combination of references. In Keller, 208 USPQ 871 (CCPA 1981).

On pages 12-13, Applicant's stated that there is no suggestion in either Lands or Watanabe to combine two references. However, in response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, to provide a power saving data processor which saves the electric power more and is easy for a user to use (See Purpose in Watanabe reference).

On pages 13-14, Applicant's stated that there is no suggestion in either Lands or Watanabe and Schults et al. to combine three references. However, in response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art.

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See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, to provide a power saving data processor which saves the electric power more and is easy for a user to use (See Purpose in Watanabe reference) and to provide detecting presence of an object (See Col. 3, Lines 51-54 in the Shultz et al. reference).

On page 14, 1st paragraph of Remarks, in relation to claim 12, Applicant stated that Schultz teaches away by indicating that trigger circuitry should not be prevented from going to idle mode after a time is expires. However, Schultz teaches that to exit idle mode as soon as OPS assert (See Fig. 8).

On page 14-15 of Remarks, in relation to claim 14, Applicant stated that that Anderson does not disclose all limitations of claim 14. But orientation context value limitation was shown by Lands. However, Applicants cannot show non-obviousness by attacking references individually where, as here the rejections are based on combination of references. In *Keller*, 208 USPQ 871 (CCPA 1981).

With respect to claims 31-33, the argument is moot in view of the new ground of rejection.

Telephone Inquire

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Leonid Shapiro whose telephone number is 571-272-7683. The examiner can normally be reached on 8 a.m. to 5 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richard Hjerpe can be reached on 571-272-7691. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

LS
06.10.06



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